

U.S. Application No.: 09/604,285
Attorney Docket No.: EP-7041-Div

presented in view of the Examiner's Amendment dated March 28, 2001 in the parent reissue application. It adapts the format and column and line citation presented in the Examiner's Amendment consistent with MPEP Section 1453 and 37 C.F.R. §1.173(b)(1).

The changes are presented in an Appendix for the convenience of the Examiner.

Rejection of claims 22-40 and 42-54 under 35 USC 103(a)

The Examiner rejected claims 22-40 and 42-54 under 35 U.S.C. 103(a) as being unpatentable over Thorsell et al (US 4,648,985) combined with Applicant's alleged admission in view of de Vries (US 4,394,279). As discussed during the interview of September 24, 2002 the rejection based on Thorsell et al is improper and must be withdrawn because the Patent Office has twice allowed the invention over this reference (i.e., in the parent patent U.S. 5,650,381 and also the reissue RE 37,363E). The difference in the instant claims is the range of the components, but not the chemical composition.

The Examiner's suggested combination of Thorsell et al "with Applicants' admission in view of Louis de Vries (de Vries 4,394,279)" is improper and any rejection based thereon should be withdrawn. Applicants have acknowledged de Vries as a public reference (column 1, line 56 to column 4, line 1) but only in the context of describing their inventions. Applicants' description of their invention cannot constitute a prior art "admission." Applicants have made no "admission" that molybdenum compounds, which are substantially free of active sulfur, have, prior to the Applicants' instant invention, been used in combination with diarylamines. Applicants respectfully request the Examiner to reconsider and withdraw the rejection.

*Prin art
of 5-650381
col. 1253-59*

U.S. Application No.: 09/604,285
Attorney Docket No.: EP-7041-Div

Rejection of Claim 55 under 35 U.S.C. 103 and 112, second paragraph

The Examiner rejected claim 55 under both 35 U.S.C. 103(a) and 35 U.S.C. 112, second paragraph. Claim 55 has been canceled herein without prejudice or disclaimer.

*most
cancellation*

Rejection of Claims 22-54 under 35 U.S.C. 251

The Examiner rejected claims 22-54 under 35 U.S.C. 251 as being based on new matter added to the patent for which reissue is sought.

As was discussed in detail at the interview, this rejection is in error. No new matter has been added.

Claims 22, 23 and those dependent thereon, find support in the original specification, including its disclosed weight ratios. At column 2 under Summary of the Invention, Applicants present at least five exemplary aspects of their invention. In the third paragraph Applicants taught an embodiment of their invention is directed to concentrates wherein a clearly defined weight ratio is taught. More particularly, Applicants additionally disclosed defined weight ratios for lubricant compositions, such as in column 6 lines 55-64. Applicants referred to exemplary support for their reissue claims when filing the present reissue application and they respectfully invite attention to their Continuation Reissue Oath, page 3, ¶10. Therefore, no new matter or unsupported matter has been added or claimed, and the rejection of claims 22-54 should be withdrawn.

*No only
specific
to new to
amend
Not to
750 to
7500*

Claims 53 and 54 have been canceled herein and replaced, pursuant to the discussion at the interview of September 24, 2002, with new claims 56 and 57.

*most
cancellation*

FEES

If any fees are required in connection with this Response and Amendment, please charge our Deposit Account No. 05-1372.

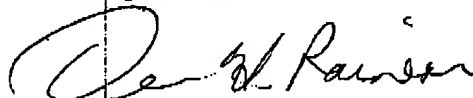
U.S. Application No.: 09/604,285
Attorney Docket No.: EP-7041-Div

CONCLUSION

It is therefore respectfully submitted that claims 22-40, 42-52 and 56-57 are in condition for allowance.

If the Examiner feels that a telephone communication will be useful in the prosecution of this application, she is encouraged to contact the undersigned attorney.

Respectfully submitted,



Dennis H. Rainear
Reg. No. 32,486
Ethyl Corporation
330 South Fourth Street
Richmond, VA 23219
Telephone: 804-788-5516
Facsimile: 804-788-5519

September 27, 2002

U.S. Application No.: 09/604,285
Attorney Docket No.: EP-7041-Div

APPENDIX

VERSION SHOWING AMENDMENT TO SPECIFICATION

Page 1, after the title, the following new paragraph is inserted:

Application Serial No. 09/604,285 filed June 26, 2000, and its parent application 09/359,770 filed July 22, 1999 and now Re 37/363E, are each reissues of U.S. Patent No. 5,650,381, which was granted from application serial no. 08/559,879 filed November 20, 1995.

VERSION OF CLAIMS TO SHOW CHANGES MADE

Amended claim 30 to be added in the reissue now reads as follows:

30. A lubricating composition according to claim 22 or 23, wherein the molybdenum compound is at least one of molybdenum naphthenate, molybdenum octoate or molybdenum 2-ethylhexanoate.

Claims 53, 54 and 55 are canceled

Claim 56 is added as a new claim.

56. A method for lubricating an engine comprising adding a lubricating composition of claim 22 or claim 23 to said engine.

Claim 57 is added as a new claim.

57. An engine lubricated according to the method of claim 56.

PTO/SB/97 (08-00)

Approved for use through 10/31/2002, OMB 0651-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

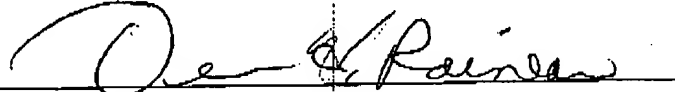
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Certificate of Transmission under 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the
United States Patent and Trademark Office - Examiner Margaret B. Medley,
Art Unit 1714, FAX No.: 703-872-9311

on September 27, 2002
Date

Response and Amendment due
10/09/02, Ser. No. 09/604,285 -
Attorney Docket No. EP-7041-Div


Signature

Dennis H. Raineau, Reg. No. 32,486

Typed or printed name of person signing Certificate

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

Burden Hour Statement: This form is estimated to take 0.03 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.